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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/158,549

09/22/1998

JOHN S. HENDRICKS

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09/27/2006

PATTERSON & SHERIDAN, LLP/  
SEDNA PATENT SERVICES, LLC  
595 SHREWSBURY AVENUE  
SUITE 100  
SHREWSBURY, NJ 07702

EXAMINER

BROWN, RUEBEN M

ART UNIT

PAPER NUMBER

2623

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	Application No. 09/158,549	Applicant(s) HENDRICKS ET AL.	
	Examiner Reuben M. Brown	Art Unit 2623	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 01 August 1706 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1, 2, 4-6, 16-17, 19-21 & 43-45.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See enclosed Advisory Action.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

## **ADVISORY ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 8/17/2006 have been fully considered but they are not persuasive. The present application, filed 9/22/1997, is a DIV of 08/160,194, filed 12/02/1993, which is a CIP of 07/991,074, filed 12/09/1992.

In a previous response filed 5/30/06, and in the present After final response, applicant discloses that the amended claimed subject matter of, "whereby digital data, including electronic mail is transferred from the set top terminal for processing and the processed electronic mail is passed to the set top terminal for display", is based on the 07/991,074, and was presented in order to overcome prior art rejection of Kauffman, (US Pat# 5003591), in view of Handelman, (US Pat# 5,715,315, filed 9/15/1993).

Examiner contends that the relevant subject matter is explicitly found in the 07/991,074 application and thus in the previous Office Action mailed, 6/30/06, a 112 1<sup>st</sup> paragraph rejection was made. Applicant's arguments in the present response are not persuasive. In particular, applicant's response does not point to any specific citation in the 07/991,074 application that specifically discloses that the Level B upgrade on the set top terminal actually processes electronic mail. Instead applicant points to the disclosure that the Level B upgrade supports AOL and Prodigy, and various other online services, namely, airline reservations, hotel reservations,

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encyclopedia, shopping center, games, etc. However, the Fig. 53a discussed by applicant does not explicitly disclose that electronic mail was one of the interactive services supported by the upgrade.

Therefore, on page 7, applicant asserts that the 'disclosure of the ultimate priority document inherently discloses electronic mail', emphasis added. Examiner respectfully disagrees and points out, as argued in the previous action, that AOL & Prodigy provided numerous specific services. Even though the STT generally accesses AOL and/or Prodigy, there is no requirement that the STT is inherently enabled to process all of the services available. Applicant responds, 'do not know why the examiner has the opinion that some services are not supported'. However, examiner's position is that applicant disclosure does not explicitly demonstrate that the Level B upgrade supported the specific interactive service of electronic mail.

Furthermore, even if the disclosure of AOL & Prodigy inherently enables the Level B upgrade to support electronic mail, the specific recitation of; 'at least one microprocessor connected to the said interface for processing the electronic mail to produce processed electronic mail'. There is no drawing or citation in the specification that explicitly discloses that the microprocessor of the Level B upgrade processes electronic mail to produce processed electronic mail.

In view of the discussion presented above, examiner maintains the Final Rejection, mailed 6/30/06.

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**Any response to this action should be mailed to:**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

**or faxed to:**

(571) 273-8300, (for formal communications intended for entry)

**Or:**

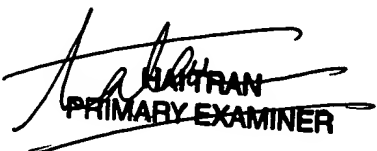
(571) 273-7290 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F (9:00-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Reuben M. Brown

  
PRIMARY EXAMINER